Office-Supreme Court, U.S.
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MAY 6 1966
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IN THE

Supreme Court of the United States

OCTOBER TERM, 1965

No. 1161

THE GOODYEAR TIRE & RUBBER COMPANY, *Petitioner*

v.

THE COMMISSIONER OF PATENTS, *Respondent*

PETITIONER'S REPLY TO RESPONDENT'S MEMORANDUM IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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Respondent seeks to condone the slipshod manner in which the administrative process is regarded by the Executive Branch, the result of which is denial of due process to the public.

Although Respondent admits at page 2 of the Memorandum in Opposition that the specimen on file at the time of the abortive publication of the mark did not satisfy the requirement of the Commissioner's rules

and that a "re-examination" was made,[1] footnote 3 at page 2 of Respondent's Memorandum in Opposition contradicts the action taken. The fact is that there was *no* specimen showing use of the mark on *any* of the goods named in the application at the time of the abortive, premature publication. That is why the application was re-examined and registration was refused *after* publication in the Official Gazette.

Respondent is less than candid in representing to the Court at page 2 of his Memorandum that petitioner "waited until the afternoon of November 23, 1964—the day before the trademark was to issue—to file an application in the District Court for a temporary restraining order". This flagrant disregard or misrepresentation of the facts is reprehensible, particularly coming to the Court in the name of the Solicitor General, himself.

The fact is that the Commissioner of Patents had "mislaid" petitioner's "Request for Reconsideration" (R. 17) to which petitioner was awaiting the Commissioner's reply, the following transactions having occurred between July 16, 1964 and November 23, 1964 (R. 10-70):

July 16, 1964—Petitioner filed "Petition to the Commissioner of Patents" (R. 9-10)

August 5, 1964—Commissioner Denied Petition filed July 16, 1964 (R. 11)

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[1] The respondent erroneously states at pages 1-2 that a "patent examiner" re-examined the trademark application involved herein. (See Section 12(a) Trademark Act of 1946, Appendix C-1, pages 10a-11a of present petition to effect that trademark applications are referred to the examiner in charge of registration of marks.)

October 2, 1964—Petitioner filed "Renewed Petition to the Commissioner of Patents" (R. 12-15)

October 6, 1964—Commissioner Denied "Renewed Petition" (R. 15-16)

October 9, 1964—Petitioner filed "Request for Reconsideration of Decision of Commissioner of Patents and Renewed Petition to Withhold Issuance of Registration" (R. 17-70)

October 12, 1964—Examiner Requested Restoration of Jurisdiction over Application and Commissioner Restored Jurisdiction (R. 146)

October 12, 1964—Application Withdrawn from Issue (R. 221)

October 15, 1964—Examiner Refused Registration (R. 222-223)

October 22, 1964—Applicant filed New Specimens and Affidavit (R. 149-156)

October 22, 1964—Refusal Withdrawn in View of Submission of New Specimens and applicant notified of application being passed to issue and that it would "mature into a registration" in due course of business, no notice thereof to petitioner.

November 23, 1964—Petitioner filed Complaint and Application for Temporary Restraining Order (R. 1-74)

November 23, 1964—Court Issued Temporary Restraining Order (R. 74-75)

November 24, 1964—Examiner and Commissioner Effect Withdrawal of Application from Issue (R. 79-80)

November 25, 1964—Commissioner Denied "Mislaid" Petition for Reconsideration filed by Petitioner on October 9, 1964 (R. 81-82)

November 27, 1964—Petitioner Amended Complaint (R. 75-76)

The delay, if any, in the foregoing chronology was attributable to the Commissioner for having "mislaid" petitioner's "Request for Reconsideration" from October 9, 1964 to November 25, 1964. Thus, it was only *after* petitioner invoked the extraordinary remedy of a temporary restraining order that the Commissioner took any steps to consider petitioner's "Request for Reconsideration". *However, in the meantime, the application was being re-examined, amended and passed to issue without any notice whatever to petitioner as to the action being taken.* It was only upon making inquiry as to the status of the matter that petitioner learned that the application was about to "mature" into a registration, *without publication in the Official Gazette,* "in due course of business".

There is no authority whatever for respondent's assertion in footnote 4, page 3 of his Memorandum in Opposition that "Lack of proper specimens is not a proper ground for opposition". An opposer is likely to be damaged by issuance of a registration contrary to law, regardless of the respect in which the application is legally insufficient since a registration, once it is issued, carries a statutory presumption of validity. The cavalier fashion in which respondent disposes of such points without supporting authority illustrates the reason why the present petition should be granted.

RESPONDENT MISSTATES CITED CASES

The cases cited at pages 3-4 of respondent's "Memorandum in Opposition" are *contrary* to the proposition for which they are cited by respondent and actually support petitioner's position. In each of the cited cases the Commissioner caused the respective marks to be published a second time. In every instance in

which the question of second publication of a mark has arisen, except the present case, *the mark has been published a second time.*

On the other hand, respondent erroneously represents to this Court, at the bottom of page 3 of his Memorandum that "the Patent Office has consistently, and quite properly, *refused* to expose an applicant to a second thirty-day period for opposition" (emphasis added by petitioner). In support of this statement, respondent cites two cases, in each of which the Commissioner *published the mark a second time* and exposed the applicant to a second period for opposition.

Since the right of the Commissioner to publish a mark a second time has been upheld both by the Court of Customs and Patent Appeals and the Court of Appeals for the District of Columbia Circuit we now have an anomalous situation where the Commissioner, in the face of the precedents, *refuses* to publish a mark a second time. This type of conflict, particularly since it involves an abuse of the administrative process, cries out for rectification by this Court.

THE QUESTION OF LAW

Petitioner submits that the point of law involved here must be stated as follows:

> "A trademark registration may not be validly issued without further publication if, at the time of initial publication in the Official Gazette for opposition as provided in Sections 12(a) and 13 of the Trademark Act of 1946, the application was not in compliance with all statutes and rules relating to registration of marks."

Respondent's version would allow for publication of a mark when the application is not in compliance with

the statutes or rules and then would permit unlimited amendments thereto after the period for opposition had expired, thereby precluding the public from ever opposing the issuance of an invalid registration. It is the right of the public to oppose under Section 13 of the Trademark Act of 1946 which is involved here—not recourse to other statutes or other remedies at other times.

SUMMARY DISPOSITION

In view of the undisputed facts in the present case, petitioner respectfully submits that the present matter may be disposed of summarily by the Court granting the present petition, reversing the judgment of the Court of Appeals for the District of Columbia Circuit and directing the Court to require the Commissioner of Patents to publish the mark in its present condition in accordance with Section 12(a) of the Trademark Act of 1946.

If the Court does not consider the matter ripe for determination in a summary way, petitioner prays that, at least, the petition be granted and the case be set for briefing and oral argument on the merits.

Respectfully,

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